

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 16 and 23-42 are pending in this application. Claims 23, 24, 26-28, 32-34 and 38-42 stand rejected. Claims 16, 25, 29-31 and 35-37 are withdrawn from consideration. Claims 23, 26, 29, 32 and 40 have been amended to delete reference to fluthiacet and oxasulfuron in possible combination with glufosinate and glyphosate. No new matter has been added by this amendment.

The Advisory Action indicated that the after final amendment filed on 1 February 2005 had been entered and that the amendment to the claims had overcome the 35 U.S.C. 102 rejection.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 23, 24, 26-28, 32-34 and 38-42 were rejected as allegedly being obvious over Lee et al. (U.S. Patent 6,586,367 - Lee).

With the amendment of claims 23, 26, 29, 32 and 40 to exclude the combination of glufosinate or glyphosate with fluthiacet or oxasulfuron, there is no longer any overlapping embodiments between Lee and the present invention. The primary support for the holding of obviousness appears to be the Examiner's assertion that Lee refers to glufosinate and glyphosate in combination with a limited group of second herbicides, i.e. metolachlor, fluthiacet, or oxasulfuron. Even if this assertion was accepted, this would not render the present claims to be obvious as this combination is outside of the scope of compositions being claimed by the applicants. In order to establish a *prima facie* case of obviousness, all claim limitations must be taught (see MPEP 2143.03).

Moreover, the applicants do not concede that the combination of glufosinate and glyphosate with a limited group of second herbicides, i.e. metolachlor, fluthiacet, or oxasulfuron would have been obvious in light of the state of the art at the time the invention was made. The applicants disclosed numerous examples showing unexpectedly superior herbicidal effects using various embodiments of the applicants claimed invention (see pages 33-38 of the specification; the Declaration by Dr. Erwin Hacker dated February 20, 2003) and provide additional data attached as an enclosure to this response which shows unexpected herbicidal effects.

The Lee reference is even further removed from the applicants' claimed invention in that the applicants show that the unexpectedly superior results are possible when combining an herbicidal agents which alone have little (see e.g. page 4, Table 4) or even no effect (see e.g. page 33, Table 2, B2.5 and page 37, Table 9, B1.1). The Examiner's characterization of Lee's teaching as being obvious for combining two compositions which are useful for the same purpose is only relevant when the two compositions have herbicidal activity and even then only for the benefits expected by those of ordinary skill in the art with such a combination. Lee provide neither direction nor an expectation of surprisingly superior results when using herbicidal agents that alone have little or no effectiveness.

Therefore, for any of the above reasons, the Lee reference does not render the pending claims to be obvious.

III. REQUEST FOR REJOINDER

Should claims 23, 24, 26-28, 32-34 and 38-42 be held to be allowable, the applicants respectfully request that claims 16, 25, 29-31 and 35-37 be rejoined.

REQUEST FOR INTERVIEW

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in

advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office.” *Id.*).

PETITION FOR EXTENSION OF TIME

Pursuant to the provisions of 37 C.F.R. §1.136(a)(1), applicants hereby petition for an extension of time of **two months**. Granting of Applicants’ request would serve to extend Applicants’ due date from May 1, 2005 to July 1, 2005.

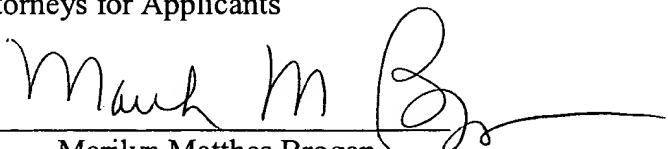
Enclosed is a check in the amount of \$450.00 to satisfy the fee for a two (2) month extension of time. The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Account No. 50-0320.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By 
Marilyn Matthes Brogan

Reg. No. 31,223

Howard C. Lee

Reg. No. 48,104

745 Fifth Avenue

New York, New York 10151

(212) 588-0800